<u>**REMARKS**</u>

Claims 1-23 and 41 are currently pending in the subject application and are presently under consideration. Claims 1, 7, 8, 15 have been currently amended while claims 14-16-18, and 24-40 have been canceled. New claim 41 is added. A listing of claims is shown on pages2-5 of the Reply. Applicants' representative thanks the Examiner for the telephone interview of June 16, 2008 wherein merits of the claims were discussed. It was agreed that the proposed amendments to the claims overcome existing rejections.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   <u>Rejection of Claims 1-23 Under 35 U.S.C. §101</u>

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The Federal Circuit has clearly established in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) that inventions such as that claimed by applicant is statutory.

> This court must also decide whether software code made in the United States and exported abroad is a "component of a patented invention" under 271(f)... Section 271(f) refers to "components of a patented invention."... Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter."... Without question, ***software code alone qualifies as an invention eligible for patenting under these categories***, at least as processes. *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005). (Emphasis added).

The Federal Circuit in *Eolas Techs., Inc. v. Microsoft Corp.* clearly established that software code alone is statutory subject matter. Independent claim 1 (and similarly recited in new independent claims 15) recites a ***computer implemented ... system***. A

system by itself is statutory subject matter. By the standards set forth in the above decision, a computer implemented system in the form of software, hardware, or the combination of both clearly falls within the categories of statutory subject matter. However, in order to expedite prosecution claim 1 (and similarly independent claim 15) has been amended to recite that the system comprises a processor executing the claimed components.

In view of at least the foregoing, it is readily apparent that applicant's invention as recited in independent claims 1 and 15 (and associated dependent claims 2-14 and 16-23) is statutory subject matter. Accordingly, withdrawal of this rejection is respectfully requested.

II.   Rejection of Claims 1-23 Under 35 U.S.C. §102(b)

Claims 1-23 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Herrmann (US 5,995,756). Withdrawal of this rejection is requested for at least the following reasons. The cited reference fails to disclose or suggest an identical invention as set forth in the subject claims.

> A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim*. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim*. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

The claimed subject matter generally relates to creation and processing of customized documents in a client/server environment with embedded or linked code that can be run on the client inside of the host application or on the server with out invoking the host application. A transparent data island is automatically generated for the customized document that is embedded in the document and can be edited while requiring only a subset of all components of the host application to be running or no components of the host need run on the server at all. To this end, independent claims 1,

15 recite similar features namely: *the data island is modified on the server without having to start the host application on the server and contents of the data are synchronized with the document contents when the document runs inside the host application.* Such aspects are not taught or suggested by Herrmann.

Hermann relates to a form based development environment for partitioning an application such that it can be seamlessly integrated into corporate webs (intranets). A form is implemented as an "application page" and published as an ActiveX object. Specifically, a new "application" page MIME type is defined: application/x-appdoc. This contains information necessary to create a document (e.g., Microsoft ActiveX Document) locally but, in addition, also includes information necessary to find and download the program code for rendering the view of the document. If the program code is already present locally, it need only be downloaded for purpose of updating the local copy. Once a form is built into an ActiveX object and digitally signed, it can be downloaded to a client and run in a Web browser, such as Microsoft Internet Explorer. (See Hermann Abstract).

On page 8 of the subject Office Action it is erroneously contended that Hermann teaches a data island as recited in the subject claims. At the cited portion, Hermann teaches different downloading models for downloading code that is not present on the client machine for running the application page and detailed methodologies for implementing document and view objects of ActiveDoc server (*See* Hermann col. 9 lines 49-58 and col. 15 lines 40-45). When a browser on the client side receives a file from the server it determines how to display the file. This display process is carried out in two steps First an in-memory Document object is created and filled with data from the file received from the server. The Document object creates a View object that is attached to a user-interface frame (or a web browser) (*See* Hermann col. 11 lines 25-45). However, nowhere does Hermann teach or suggest that the document object facilitates data modification on the server without launching the host application or by utilizing only a subset of components of the host application as recited in independent claim 15.

In contrast, the claimed subject matter relates to a data island that can be accessed and modified on the server without having to start the host application. Moreover, each time the document runs inside the host application, the contents of this data island are

synchronized with the document contents. Additionally, the generated data model is connected to the data island so that the data model works directly against data. Changes to the data model are then moved into the document contents *via* a data binding mechanism (*See* applicants' specification as filed section labeled "Data Island Transparency).

In view of at least the aforementioned it is concluded that Hermann fails to teach or suggest an identical invention as recited in the subject claims. Hence, withdrawal of this rejection is requested with respect to independent claims 1, 15 and all claims that depend there from.

III.   New claim 41

New claim 41 emphasizes novel aspects of the invention discussed *supra* in connection with claims 1-23. Accordingly, this claim is patentably distinct over the art of record for at least the same reasons as are claims 1-23.

<center>CONCLUSION</center>

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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